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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,626	05/18/2004	John Elasic	12051-00001-US	3625

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EXAMINER

CLEMENT, MICHELLE RENEE

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/709,626	ELASIC, JOHN	
	Examiner	Art Unit	
	Michelle (Shelley) Clement	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection as necessitated by applicant's amendments. However it is noted that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). And a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, it is generally well accepted in the field of the art that the term shield refers to armor. It is further noted that virtually anything can be a handle as long as a hand can grip the element.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5, 8, 10, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seely (US Patent # 33,854) and Sankar (US Patent # 4,412,495). Seely discloses a ballistic

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shield comprising a shield having a front face and a reverse face and formed of a ballistic material, straps that can be used as handles associated with the shield that can be used for carrying the shield or holding the shield in front of at least a portion of a user's body or used as a forearm cuff and multiple firearms mounted to the shield and dischargeably operable when so mounted, wherein the firearm is mounted for discharge in a direction at an angle outwardly from the front face of the shield. The firearm is a gas discharge firearm. The firearms are mounted so that they discharge in a plurality of directions including a direction substantially perpendicular to the front face of the shield. The firearms are mounted to both the front face and rear face of the shield. The shield can be employed and the firearm can be discharged with a single arm.

Although Seely does not expressly disclose the shield having a viewing window or a specific handle (rather than straps that can be used as handles) associated with the shield, Sankar does. Sankar teaches a ballistic shield made of a light-weight material having handles (reference 18) and a viewing window (reference 16) to protect the entire body of a person. Sankar and Seely are analogous art because they are from the same field of endeavor: protective shields. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the light weight materials including a viewing window and handles as taught by Sankar with the shield as taught by Seely. The suggestion/motivation for doing so would have been to obtain a protective portable battery that was lighter weight and covered a larger, thereby offering more protection while being easier to carry. It is noted that the [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use.

Thus, these claims as well as other statements of intended use do not serve to patentably

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distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seely and Sankar as applied to claim 1 above. Seely and Sankar disclose the claimed invention except for the specific ballistic material selected from the claimed group or the material of the viewing window specifically selected from the claimed group. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the specific materials in making the shield, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and Sankar discloses that such known materials are used in the construction of the shield. *In re Leshin*, 125 USPQ 416.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seely and Sankar as applied to claims 1 and 10 above. Seely and Sankar disclose the claimed invention except for the second firearm specifically mounted so that it discharges in a direction substantially parallel

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to the rear face of the shield. It would have been obvious to one of ordinary skill in the art at the time the invention was made to mount one of the additional firearm in such an orientation, since it has been held that rearranging parts of an invention involves only routine skill in the art and Seely discloses the firearms being oriented in at diverging angles to cover a greater area. *In re Japikse*, 86 USPQ 70.

6. Claims 6, 7, 13, 14, and 16 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Seely and Sankar as applied to claim 1 above, and further in view of Resnick (US Patent # 6,272,781). Although neither Seely nor Sankar expressly disclose a taser gun and battery mounted to the shield, Resnick does. Resnick teaches a ballistic shield comprising a shield having a front face and a reverse face and formed of a ballistic material; a handle associated with the shield and a taser gun mounted to the shield and dischargeably operable when so mounted. Although Resnick does not expressly mention the battery it is inherent that a power source (i.e. battery) would be present, since the taser gun would not operate without such a source. The shield further comprising a disabling sensor the disable the firing devices in response to a predetermined signal or a predetermined absence of a signal. The shield comprising a plurality of communication accessories mounted to the shield selected from the claimed group, and further comprising a plurality of light sources. Seely, Sankar and Resnick are analogous art because they are from the same field of endeavor: protective shields. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the taser gun as taught by Resnick with the shield taught by Seely and Sankar. The suggestion/motivation for doing so would have been to obtain a shield that provided additional protections and advantages as suggested by Resnick.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seely and Sankar as applied to claim 1 above, and further in view of Lobdell (US Patent # 1,227,544). Although neither Seely nor Sankar expressly disclose a mirror associated with the viewing window, Lobdell does. Lobdell teaches a mirror that can be mounted on a firearm to increase the field of vision. Lobdell, Seely and Sankar are analogous art because they are from similar problem solving areas: protection while firing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the mirror as taught by Lobdell with the firearms and shield taught by Seely and Sankar. The suggestion/motivation for doing so would have been to obtain a shield that had an extended field of view.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seely, Sankar and Resnick. See ¶ 6 above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tocci et al. (US Patent # 6,367,943).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "M Clement", is located in the bottom right corner of the page.